

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

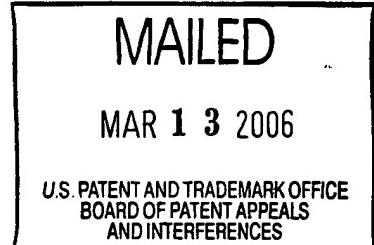
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHAD A. STEVENS

Appeal No. 2005-2245
Application No. 09/888,215

ON BRIEF



Before JERRY SMITH, BARRY, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, 9, 10, 12-19, and 25. Claims 5-8, 11, and 20-24 have been canceled.

Invention

Appellant's invention relates to a method, print medium, kit, and method of providing a kit for an electrostatic sticker. The present invention may be embodied and described as a system for producing a user-customized electrostatic sticker. The system includes a host computer for generating a user-selected image; a printer connected to the host computer for receiving print data corresponding to the user-selected image; and a sticker print medium on which the user-selected image is printed with the printer to produce the user-customized sticker. The print medium includes an electrostatic charge that allows the medium to be adhered to a surface as an electrostatic sticker. Preferably, the printer is an inkjet printer. The present invention also encompasses, or can be phrased as, a method of making a user-customized electrostatic sticker by printing a user-selected image on sticker print medium, the sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that the sticker print medium functions as an electrostatic sticker.

Appellant's specification at page 3.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium,
said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker; and

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depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of said sticker print medium.

References

The references relied on by the Examiner are as follows:

Chamberlain	2,293,887	Aug. 25, 1942
Greenberg	3,589,507	Oct. 8, 1971
Suzuki et al. (Suzuki)	4,882,621	Nov. 21, 1989
Rubino	4,992,121	Feb. 12, 1991
Longtin	5,334,431	Aug. 2, 1994
Naik et al. (Naik)	5,579,446	Nov. 26, 1996
Floegel et al. (Floegel)	6,284,339	Sep. 4, 2001

(Filed December 9, 1997)

Rejections At Issue

Claims 1, 9, and 10 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Floegel and Chamberlain.

Claims 2 and 4 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Floegel, Chamberlain and Suzuki.

Claim 3 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Floegel, Chamberlain, Suzuki, and Naik.

Claims 12-14 stand rejected under 35 U.S.C. § 102 as being anticipated by Floegel.

Claims 12-15 stand rejected under 35 U.S.C. § 102 as being anticipated by Longtin.

Claims 16-19 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Chamberlain and Greenberg.

Claim 25 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Rubino and Greenberg.

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Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 12-15 under 35 U.S.C. § 102, and we affirm the Examiner's rejection of claims 1-4, 9, 10, 16-19, and 25 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal the claims stand or fall together in four groupings:

Claims 1-4, 9, and 10 as Group I;

Claims 12-15 as Group II;

Claims 16-19 as Group III; and

Claim 25 as Group IV.

See page 5 of the brief. Furthermore, Appellant argues each group of claims separately and explains why the claims of each group are believed to be separately patentable. See pages 8-15 of the brief and pages 2-9 of the reply brief. Appellant has fully met the

¹ Appellant filed an appeal brief on July 26, 2004. Appellant filed a reply brief on December 20, 2004. The Examiner mailed an Examiner's Answer on October 21, 2004.

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requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. We will, thereby, consider Appellant's claims as standing or falling together in the four groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;

Claim 12 as a representative claim of Group II;

Claim 16 as a representative claim of Group III; and

Claim 25 as a representative claim of Group IV.

II. Whether the Rejection of Claims 1-4, 9, and 10 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1-4, 9, and 10. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977

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F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Appellant argues at pages 10-12 of the brief and pages 5-7 of the reply brief that the rejection of claim 1 based on the Floegel and Chamberlain references cannot be sustained. We disagree.

As pointed out by the Examiner, Chamberlain discloses at col. 1, line 55, through col. 2, line 7, depositing an electrostatic charge on a sticker print medium wherein the charge donor is separate from said print medium. We note that Chamberlain also teaches that the depositing may be on a print medium that has been printed with an image (the markings of figure 5 and col. 2, lines 25-27) before the depositing. A user necessarily selects the markings of figure 5 during the design of the sheet of figure 5.

In view of the above discussion, it is our view, that since Chamberlain teaches printing a user selected image on the sticker print medium prior to the depositing

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described at columns 1-2, Floegel is not necessary for a proper rejection under 35 U.S.C. § 103 of representative claim 1, as Chamberlain discloses all that is claimed.

A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." **Jones v. Hardy**, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). **See also In re Fracalossi**, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); **In re Pearson**, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Accordingly, the Examiner's obviousness rejection of representative claim 1 is sustained based on Chamberlain alone.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 12-14 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Floegel does fully meet the invention as recited in claims 12-14. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 12, Appellant argues in the brief and reply brief that in Floegel the charge is not "deposited", the charge is not on "a side of said sticker print medium," and the "protective backing is not over said electrostatic charge" as

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required by the claim. We disagree as our review of Floegel finds all the features argued by Appellant.

At column 3, lines 16-19, Foegel discloses that a polyester film (sticker print medium) is subjected to an electric field and corona discharge to charge the film. Appellant's claimed "an electrostatic charge deposited" is sufficiently broad to include Floegel's charged film. Also, even if Floegel were silent as to how the charge came to be on his film, the Examiner is correct that "deposited" is only a limitation on the method of making the sticker (i.e., it is a product-by-process type limitation), and such a limitation is anticipated by a description of the claimed charged structure regardless of how the charge is produced. See MPEP 2113 for a general discussion of product by process claims. Further, we note that Appellant has specifically stated that he did not invent depositing an electrostatic charge on one side of an electrostatic sticker at paragraph [07] of his specification.

As pointed out by the Examiner, Floegel teaches charging the entire sheet. As to Appellant's argument that "the charge is not on "a side of said sticker print medium," (rather it is on the sheet), this argument fails because the claimed limitation of "a side" is not limited to "one side only." Rather, the proper claim construction of "a side" is "one or more side." **See KCJ Corp. v. Kinetics Concepts Inc.**, 55 USPQ2d 1835,1839. (Fed. Cir. 2000.) As noted before, the claim language itself governs claim scope. **See Vitronics**, 90 F.3d at 1582. This court has repeatedly emphasized that an indefinite article "a" or "an" in patent parlance carries the meaning of "one or more" in open-ended claims

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containing the transitional phrase “comprising.” (Citations omitted). Unless the claim is specific as to the number of elements, the article “a” receives a singular interpretation only in rare circumstances when the patentee evinces a clear intent to so limit the article. **See AbTox**, 122 F.3d at 1023, 43 USPQ2d at 1548. Under this conventional rule, the claim limitation “a,” without more, requires at least one.

We find nothing in Appellant’s disclosure as originally filed that evinces a clear intent to limit the sticker to only having a charge on one side. That is, nothing that requires the second side must remain uncharged (or have some other characteristic). The disclosure appears to be silent on this matter. Also, we again note that Appellant has specifically stated that he did not invent depositing an electrostatic charge on one side of an electrostatic sticker at paragraph [07] of his specification.

Lastly, since the entire sheet in Floegel is charged, necessarily the protective backing is over said electrostatic charge.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

VI. Whether the Rejection of Claims 12-15 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Longtin does fully meet the invention as recited in claims 12-15. Accordingly, we affirm. With respect to independent claim 12, as with Floegel above, Appellant argues that his claim distinguishes over the Longtin reference by pointing out that Longtin fails to teach “a side” and “a deposited charge.” We disagree.

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As we discussed above with respect to Floegel, “a side” does not have the claim construction argued by Appellant. In this instance, as pointed out by the Examiner, Longtin describes a label with a static electrical charge on it. That the charge of Longtin is on both sides of the label anticipates the claimed “a side.”

Also, as we discussed above with respect to Floegel, even if Longtin is silent as to how the charge came to be on his film, the Examiner is correct that “deposited” is only a limitation on the method of making the sticker (i.e., it is a product-by-process type limitation), and such a limitation is anticipated by a description of the claimed charged structure regardless of how the charge is produced.

Lastly, Appellant argues that Longtin does not teach that the labels (stickers) are simultaneously blank, charged, and on a protective backing. We agree with Appellant that the Examiner has erroneously interpreted figure 1 to show a blank label. As to the Examiner’s rationale (page 12 of the answer) as to the teachings at figure 2 and column 1 of Longtin, we find that it is unnecessary to address the discussion. Longtin at figure 2 and the associated disclosure describes a sheet, a charge, and a protective backing. No further description is needed to anticipate claim 12. In addition to the sheet, charge, and backing, Longtin describes nonfunctional descriptive material in the form of printing (32). Longtin does not teach a nonfunctional descriptive material limitation in the form of a total lack of printing. However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ

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401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). In the situation before us, the Appellant has simply removed the non-function descriptive material from the prior art device. Such does not serve to distinguish over the prior art structure.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

VIII. Whether the Rejection of Claims 16-19 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 16-19. Accordingly, we affirm.

With respect to independent claim 16, Appellant again argues that the limitation of being a "blank" sheet distinguishes over the prior art. We disagree. As discussed above with respect to Longtin, descriptive material (or lack thereof) is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability.

Appellant also argues that Greenberg does not suggest packaging the claimed materials together into a kit. We disagree. Chamberlain describes all the components of claim 16 used together to adhere a decorative sheet material to a wall using an electric charge from a charge donor (title and col. 1, line 25, through col. 2, line 7). Chamberlain fails to describe putting all these components into a kit as claimed. However, Greenberg describes a wall decorating kit that provides the advantage of a "complete" (col. 4, line 23)

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"do-it-yourself" (col. 1, lines 14-15) package of materials. Given the combined disclosures of Chamberlain and Greenberg, it would have been obvious to implement Chamberlain's components in a Greenberg type kit in order to get the advantage of a complete do-it-yourself kit as taught by Greenberg. Appellants have done nothing more than use known techniques for their intended purpose to achieve an entirely expected result.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the reasons as set forth above.

V. Whether the Rejection of Claim 25 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 25. Accordingly, we affirm.

With respect to independent claim 25, Appellant argues in the brief and reply brief:

Rubino teaches an "electrostatically chargeable intermediate sheet" (abstract) that is used to adhere another sheet or object to a support surface. This is clearly not a teaching of an electrostatic sticker print medium on which a purchaser would print a sticker image.

We disagree. We find no limitation in the claim directed to "a purchaser" or "printing a sticker image." Claim 25 at most requires that someone could at a later time print on the sticker medium. Such a future use limitation fails to structurally distinguish the claimed sticker medium over the teaching of Rubino. Also, even if we gave weight to this future use limitation, nothing in Rubino precludes printing on the electrostatically chargeable intermediate sheet.

Appellant also argues that Rubino and Greenberg do not suggest packaging the claimed materials together into a kit. We disagree. Rubino describes all the components of claim 25 used together to adhere a decorative material to a surface (such as a wall) using an electric charge from a charge donor (abstract, col.1, line 17, and col. 2, lines 26-32). Rubino fails to describe putting all these components into a kit as claimed. However, Greenberg describes a wall decorating kit that provides the advantage of a "complete" (col. 4, line 23) "do-it-yourself" (col. 1, lines 14-15) package of materials. Given the combined disclosures of Rubino and Greenberg, it would have been obvious to implement Rubino's components in a Greenberg type kit in order to get the advantage of a complete do-it-yourself kit as taught by Greenberg. Appellants have done nothing more than use known techniques for their intended purpose to achieve an entirely expected result.

We also note a second distinct description in Rubino of an "electrostatic sticker print medium" and "a charge donor" at col. 1, lines 48-49. Ordinary paper is a print medium and here Rubino describes converting the paper into an electrostatic charge sticker by rubbing it with a static inducing material. That it is a poor electrostatic sticker is of no consequence. Packaging the paper and the static inducing material together in a kit would have been obvious given the description of Greenberg of the advantage of a complete do-it-yourself kit for displays.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the reasons as set forth above.

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Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 12-15, and we have sustained the rejection under 35 U.S.C. § 103 of claims 1-4, 9, 10, 16-19, and 25.

AFFIRMED

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

Jerry Smith
JERRY SMITH
Administrative Patent Judge

Lance Leonard Barry
LANCE LEONARD-BARRY
Administrative Patent Judge

Allen R. Macdonald
ALLEN R. MACDONALD
Administrative Patent Judge

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